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In re Application of SUDO et al	:	
U.S. Application No.: 10/070,328	:	
Int. Application No.: PCT/US00/17024	:	
Int. Filing Date: 21 June 2000	:	DECISION
Priority Date: 21 June 1999	:	
Attorney Docket No.: 32390-178943	:	
For: THIENYLHYDRAZON WITH DIGITALIS-	:	
LIKE PROPERTIES (POSITIVE INOTROPIC	:	
EFFECTS)	:	

This is in response to applicant's "Petition and Fee to Delete and/or Add to Original Erroneously Named or Not Named Inventor(s) in Declaration-Nonprovisional Application-- (37 C.F.R. § 1.48(a))" filed 08 April 2003, which is being treated under 37 CFR 1.497(d).

### **BACKGROUND**

On 21 June 2000, applicant filed international application PCT/US00/17024, which claimed priority of an earlier United States application filed 21 June 1999. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 December 2001.

International application PCT/US00/17024 became abandoned as to the United States at midnight on 21 December 2001 for failure to pay the basic national fee.

On 06 March 2002, applicant filed a petition under 37 CFR 1.137(b).

On 04 June 2002, this Office mailed a decision granting the 06 March 2002 petition.

On 09 September 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497(d) must be filed.

On 12 November 2002, applicant filed an executed declaration.

On 07 March 2003, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration lists inventors who are not listed in the international application.

On 08 April 2003, applicant filed the present petition under 37 CFR 1.497(d).

### **DISCUSSION**

Applicant is advised that a proper declaration has not been filed. Specifically, it is not sufficient to submit only the signature page of a declaration. For example, the declaration filed 12 November 2002 contains one of Page 1, three of Page 2, six of Page 3, and four of Page 4. Similarly, the declaration filed 08 April 2003 contains one of Page 1 and two of Page 2. Applicant must file either (1) a single complete declaration executed by all of the inventors or (2) multiple complete declarations, wherein each inventor's signature appears on at least one of the multiple complete declarations.

37 CFR 1.497(d) (effective 07 November 2000) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, applicant has provided the requisite statements.

With regard to item (2) above, applicant has provided the requisite processing fee.

With regard to item (3) above, in situations where an assignee consents to a correction of inventorship, ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b), ownership is established by documentary evidence of a chain of title from the original owner to the assignee. In the present case, the two assignees are University of Maryland, Baltimore and Universidade Federal do Rio de Janeiro.

#### **University of Maryland, Baltimore**

The respective interests of inventors 1-3 have been assigned to the University of Maryland, Baltimore. Applicant has specified by reel and frame where the assignment has been recorded in the USPTO.

Universidade Federal do Rio de Janeiro

The respective interests of inventors 4-13 have been assigned to Universidade Federal do Rio de Janeiro. Applicant has provided a copy of the assignment agreement which evidences the chain of title.

**CONCLUSION**

For the reasons above, the petition under 37 CFR 1.497(d) is GRANTED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a new Notification of Defective Response (Form PCT/DO/EO/916), which should indicate that a proper oath or declaration, as discussed above, must be filed.



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